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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,880	05/25/2001	Gustav Tappe	LE 00 022	8018

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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/24/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,880

Applicant(s)

TAPPE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-16, 19-21 and 25-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-16, 19-21 and 25-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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This is in response to Paper filed on 03 July 2003.

A. A careful studying of the instant application unveils that almost or mayor salt is ammonium. The instant claims are open to all known salt in the art.

B.1. Claims 13-16, 19-21 and 25-58 are generic to a plurality of disclosed patentably distinct species comprising many possible iron (III) complex salts in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

2. Claims 13-16, 19-21 and 25-58 are generic to a plurality of disclosed patentably distinct species comprising many possible salts of thiosulfate in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

3. Claims 13-16, 19-21 and 25-58 are generic to a plurality of disclosed patentably distinct species comprising many possible iron (III) complex salts. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

4. Claims 13-16, 19-21 and 25-58 are generic to a plurality of disclosed patentably distinct species comprising sulfite, disulfite and sulfinic acid. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

5. Claims 13-16, 19-21 and 25-58 are generic to a plurality of disclosed patentably distinct species comprising many possible salts of sulfite or disulfite in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

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6. Claims 13-16, 19-21 and 25-58 are generic to a plurality of disclosed patentably distinct species comprising many possible salts of phosphate (as elected on the record) in the art.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

7. Claims 13-16, 19-21 and 25-58 are generic to a plurality of disclosed patentably distinct species comprising many possible complexing agents in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

C. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. The groups of claims (13-16, 19-21, 25-29), (30-31, 33-43) and (44-45, 48-58) (have not been considered as patentably different or distinct. Therefore, no restriction among them is made. Accordingly, no separate search is considered or made. Independent claim 13 is considered as the main invention. Claims 14-16, 19-21, 25-31, 33-44 and 48-58 are considered as the secondary embodiments.

Should applicants urge or show otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made for the

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record as urged or shown by applicants), drawn to a bleach-fixing composition, classified in class 430, subclass 460.

- II. Claim 32, drawn to a process of making a ready-to-use bleach-fixing composition, classified in class 430, subclass 450.
- III. Claim 46, drawn to a containing, storing or aging process, classified in class 215, subclass 1+.
- IV. Claim 47, drawn to a regenerating process, classified in class 430, subclass 400.

The inventions of Groups II, III and IV are all related to the processes but have the patentably different and distinct processing steps and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the ready-to-use bleach-fixing composition as claimed can be made by another process such as first obtaining a large portion of water. Applicants should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be

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removed.

Inventions of Group I and Groups (III and IV) are related as material and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the material as claimed can be practiced with another materially different material or (2) the material as claimed can be used in a materially different process of using that material (MPEP § 806.05(h)). In the instant case, the process of either aging or regenerating as claimed can be practiced with another materially different material such as containing no phosphate as elected on the record. Applicants should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

D. However any process claim is permitted to be rejoined with a material claim provided (a) that the material claim is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

E. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

F. Other issues have not been considered until a proper election is made and resolved.

G. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers of the examiner is 703-746-7172. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
23 July 2003

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le